

**Remarks****I. Introduction**

Claims 1-28 are pending in the application. Claims 23 and 24 are in condition for allowance. Claim 15 is objected to as being dependent on a base claim. Claims 29 and 30 have been added. Claim 15 has been rewritten in independent form.

Claims 1-3, 8, 12-14, 16-19 and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Nabeshima (U.S. Pat. No. 5475209).

Claims 6, 7, 10, 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabeshima (U.S. Pat. No. 5475209).

**II. Anticipation Rejection Under 35 U.S.C. 102(b) is Improper**

The Action rejects claims 1-3, 8, 12-14, 16-19 and 25-28 under 35 U.S.C. 102(b) as being anticipated by Nabeshima (U.S. Pat. No. 5475209). Applicant respectfully traverses this rejection and requests reconsideration.

Anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

The Nabeshima references teaches a displacement measurement apparatus for displacement detection of an offset distance between a focal distance f1 of an objective lens 5 and a distance defined between the objective lens 5 and a measured surface 6. (See Nabeshima, col. 3, lns. 59-66). When the distance between the measured surface 6 and the objective lens 5 coincides with the focal distance f1 of the lens, the laser beam L (reflected from measured surface 6) focused on the four-split diode becomes an essentially circular

spot. (See Nabeshima, col. 4, lns. 26-30). Each of the four light receiving segments is sensitive to a reflection laser beam reflected from the measured surface 6 and transmitted through the mirror 4 and the beam splitter 3, to generate a laser beam sensitive to voltage. The four light receiving segments provide a feedback signal to the laser beam displacement.

The functionality and structure of Nabeshima is quite different than that of Applicant's invention of claims 1, 8, 14 and their respective dependent claims. As discussed in Applicant's specification in paragraphs 4 and 13, a feedback positioning device reads the actual position or movement of the focusing assembly. The purpose of feedback positioning device is to read (i.e., sense) the movement of the focusing assembly. The CPU executing the software then determines whether the focal depth of the laser beam is within a predetermined range based on the actual movement (i.e., displacement) of the focusing assembly. Absent from Applicant's invention is any feedback signal that is directly sensitive to the laser focus position. As such, independent claims 1, 8 and 14 have been amended to include "wherein said feedback positioning device is adapted to read the linear movement of the focusing assembly and said processor is adapted for determining based on the linear movement of said focusing assembly whether said focal depth is within a predetermined range."

As discussed in Applicant's specification in paragraph 6, movement of the focusing assembly can be measured and the movement correlated to a focal depth position. In other words, the focusing assembly can be any laser focusing device in whole or in part that is moveable, and the movement of such device can be measured by a feedback positioning device to determine if an actual focal point is achieved. Independent claims 16 and 25 have been amended to add the step of "correlating the movement of the focusing assembly to a focal depth."

Clearly, the Nabeshima reference does not teach each claim limitation of Applicant's claimed invention and in fact teaches away from Applicant's claimed invention. Applicant's claimed invention is patentably distinguishable over the Nabeshima reference. Accordingly, Applicant respectfully requests that the rejection of claims 1-3, 8, 12-14, 16-19 and 25-28 under 35 U.S.C. 102(b) as being anticipated by Nabeshima be withdrawn.

### III. Obviousness Rejection Under 35 U.S.C. 103(a) is Improper

The Action rejects claims 6, 7, 10, 11 and 22 under 35 U.S.C. 103(a) as being unpatentable over Nabeshima (U.S. Pat. No. 5475209).

In order to establish a prima facie case of obviousness, three basic criteria must be met: (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. Manual of Patent Examining Procedure § 2142. See also, *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed Cir. 1991) (emphasizing that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure). It is important to note that all three elements must be shown to establish a prima facie case of obviousness. Thus, if one element is missing, a prima facie case of obviousness does not exist.

Moreover, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Manual of Patent Examining Procedure § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)).

As discussed above, claims 1, 8 and 14 have been amended to include the limitation that "said feedback positioning device is adapted to read the linear movement of the focusing assembly and said processor is adapted for determining based on the linear movement of said focusing assembly whether said focal depth is within a certain range." Among other elements, Nabeshima does not teach this feature. As such dependent claims 6, 7, 10 and 11 are patentable over Nabeshima.

As discussed above, claim 16 has been amended to include the step of "correlating the movement of the focusing assembly to a focal depth." Among other elements, Nabeshima does not teach this step. As such dependent claim 22 is patentable over Nabeshima.

Applicant's claimed invention is patentably distinguishable over the Nabeshima reference. Accordingly, Applicant respectfully requests that the rejection of claims 6, 7, 10, 11 and 22 under 35 U.S.C. 103(a) as being unpatentable over Nabeshima be withdrawn.

#### **IV. Conclusion**

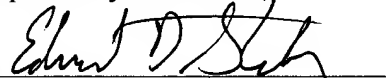
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Should the Examiner have any questions or comments, or believe that certain clarifications might more readily progress the present application to issuance, a telephone call to the undersigned Applicant's representative at 713-651-5423 is earnestly solicited.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02306US0 from which the undersigned is authorized to draw.

Dated: October 27, 2003

Respectfully submitted,

By 

Edward D. Steakley

Registration No.: 47,964

FULBRIGHT & JAWORSKI L.L.P.

1301 McKinney, Suite 5100

Houston, Texas 77010-3095

(713) 651-5423

(713) 651-5246 (Fax)

Attorney for Applicant